



M&F, LLP Docket. No. 2976-4039US1

IN THE UNITED STATES OF AMERICA PATENT AND TRADEMARK OFFICE

Applicants : Tim KEITH et al. Group Art Unit: To Be Assigned
Serial No. : 09/834,597 Examiner: To Be Assigned
Filed : April 13, 2001
For : *Novel Human Gene Relating to Respiratory Disease, Obesity, and
Inflammatory Bowel Disease*

Commissioner of Patents
P.O. Box 2327
Arlington, VA 22202

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NOV 30 2001

**STATEMENT OF FACTS IN SUPPORT OF FILING ON BEHALF OF OMITTED INVENTOR WHO REFUSES TO
EXECUTE DECLARATION (37 C.F.R. §1.47(a))**

OFFICE OF PETITIONS
DEPUTY A/C PATENTS

I, Caryn DeHoratius, hereby declare as follows:

1. I am a registered patent agent employed at Morgan & Finnegan, LLP ("Morgan & Finnegan"), 345 Park Avenue, New York, New York 10154-0053. Morgan & Finnegan has been authorized by Genome Therapeutics Corporation ("GTC"), 100 Beaver Street, Waltham, Massachusetts 02453-8443 to prosecute and handle all matters relating to the above-referenced patent application in the U.S. Patent and Trademark Office. In my capacity as a registered patent agent, I prepare and prosecute patent applications, and prepare and file accompanying documents to complete application filings. At Morgan & Finnegan, I am responsible for the handling and prosecution of the subject patent application.

2. I am making this declaration on behalf of GTC, 100 Beaver Street, Waltham, Massachusetts 02453-8443, at which the invention of the above-referenced patent application was

made and to whom the above-identified patent application is to be assigned, as to the exact facts which are relied upon to establish the diligent effort made to secure the execution of the declaration and an assignment by the non-signing joint inventor, Sunil Pandit, who refuses to execute the same in the above-identified patent application. The filing of an executed declaration in the subject application is in response to a Notice to File Missing Parts (Filing Date Granted) mailed from the United States Patent and Trademark Office ("USPTO") on June 25, 2001. A Combined Declaration and Power of Attorney document in which the remaining inventors sign for Sunil Pandit is attached as Exhibit 1.

3. I have first-hand knowledge of the facts stated herein.

**DETAILS OF OMITTED INVENTOR WHO HAS REFUSED TO SIGN APPLICATION
PAPERS**

4. The inventors of above-identified patent application are Tim KEITH, Randall LITTLE, Paul VAN EERDEWEGH, Josée DUPUIS, Richard DEL MASTRO, Jason SIMON, Kristina ALLEN and Sunil PANDIT. The application was filed on June 13, 2001, without a declaration or an assignment, and with first inventor Tim Keith named on the Application Transmittal document, a copy of which is attached as Exhibit 2.

5. A Notice to File Missing Parts of a Nonprovisional Application -- Filing Date Granted -- was mailed from the U.S. Patent and Trademark Office for this application on June 25, 2001. To prepare for submitting a declaration executed by all of the joint inventors in response to the Notice to File Missing Parts, I prepared a Combined Declaration and Power of Attorney

document (“declaration”) and an assignment document for this application, after obtaining the current residence addresses and whereabouts of the named inventors. For those inventors currently employed at GTC, I sent the declaration and assignment papers to GTC to be signed by the named inventors presently at GTC. Sunil Pandit is no longer employed at GTC. Therefore, I sent the complete patent application, including the specification, claims, drawings and abstract, along with a declaration and assignment to Sunil Pandit at his current residence address. As detailed hereinbelow, I have made several attempts to request that Dr. Pandit sign the declaration and assignment sent to him and return the completed papers for filing in the subject patent application; however, he remains unresponsive and noncompliant. Joint inventors Tim KEITH, Randall LITTLE, Paul VAN EERDEWEGH, Josée DUPUIS, Richard DEL MASTRO, Jason SIMON and Kristina ALLEN have each executed an assignment of their respective rights to the subject matter of the above-identified patent application to GTC. A true copy of the assignment filed in this application on November 26, 2001, is attached as Exhibit 3.

6. Inventor Sunil Pandit is a former employee of GTC, who, along with joint inventors T. Keith, R. Little, P. Van Eerdewegh, J. Dupuis, R. Del Mastro, J. Simon and K. Allen, invented the subject matter of the above-identified patent application during the course of their employment at GTC. These same individuals are named co-inventors on related patent application filings, namely, U.S. Serial No. 09/548,588, filed April 13, 2000; U.S. Serial No. 09/548,797, filed April 13, 2000; U.S. Serial No. 09/548,954, filed April 13, 2000, and U.S. Serial No. 09/627,937 filed July 28, 2000, the prosecution of which is being overseen at Morgan & Finnegan. A Statement of Facts accompanying a Petition under 37 C.F.R. §1.47(a) in response to a Notice to File Missing

Parts, has been submitted in each of the aforementioned applications because Sunil Pandit has refused to sign the declaration and assignment documents sent to him for execution in each of the related patent application filings.

7. Pursuant to 35 U.S.C. §116 and 37 C.F.R. §1.47(a) in the instant application, inventors T. Keith, R. Little, P. Van Eerdewegh, J. Dupuis, R. Del Mastro, J. Simon and K. Allen have executed the enclosed declaration on behalf of themselves and on behalf of non-signing joint inventor Dr. Pandit, who does not respond to or personally acknowledge my repeated attempts to contact him and to request that he sign the declaration and assignment documents sent to him. As is set forth below, Morgan & Finnegan, on behalf of GTC, has acted diligently and in good faith in making a *bona fide* attempt to request that inventor Dr. Pandit execute the declaration and assignment for the subject patent application and to obtain inventor Dr. Pandit's execution of the application papers for this patent application.

8. On August 14 ,2001, I personally sent a transmittal letter and copies of the complete patent application papers (including the specification, claims, drawings and abstract), together with a declaration and assignment for the patent application to Dr. Pandit, at the following address: 353 W Side Drive, Apt. 202, Gaithersburg, MD 20878-3028 by overnight Federal Express delivery. A true copy of the letter containing the Federal Express tracking number for the overnight delivery package is attached as Exhibit 4. In the transmittal letter accompanying the enclosed documents, I requested that Dr. Pandit read the application prior to signing and dating the assignment and declaration for patent application. Also included with the transmittal letter was a return overnight Federal Express envelope self-addressed to Morgan & Finnegan. I explained in the letter that the

self-addressed mailer was for Dr. Pandit's use in returning the signed assignment and declaration to me at Morgan & Finnegan. A copy of the self-addressed, return overnight mailing label is attached as Exhibit 5. In addition, I requested that the executed assignment and declaration be returned to me at Morgan & Finnegan in five (5) business days after he had received it. On August 20, 2001, I used the Federal Express tracking number to confirm that the application and declaration package had been delivered to Dr. Pandit's Gaithersburg, MD address. A copy of the tracking information indicating that the overnight package had been delivered is attached as Exhibit 6.

9. On August 20, 2001, six days after I had overnight mailed the complete application and the declaration to Dr. Pandit, and the same day that I had tracked the delivery of the package (See, ¶8 *supra*), I personally telephoned Dr. Pandit at his residence address in the evening after business hours to confirm that Dr. Pandit would read the application and sign the assignment and declaration as indicated in the transmittal letter. Dr. Pandit indicated that he had received the Federal Express package, but he required monetary compensation for the time required to read the application, declaration, and assignment papers. I indicated to Dr. Pandit that I did not have the authority to provide him with monetary compensation.

10. On August 30, 2001, I personally sent another letter to Dr. Pandit, which accompanied copies of the complete patent application papers (including the specification, claims, drawings and abstract), together with a declaration and assignment for the patent application. The letter and assignment were sent to Sunil Pandit's current known address at 353 W Side Drive, Apt. 202, Gaithersburg, MD 20878-3028 by overnight Federal Express delivery. A true copy of the letter containing the Federal Express tracking number of the overnight delivery package is attached

as Exhibit 7. In the transmittal letter accompanying the enclosed assignment document, I requested that Dr. Pandit read the patent application, and sign and date the declaration and assignment for the application. Also included with the transmittal letter was a return overnight Federal Express envelope self-addressed to Morgan & Finnegan. A copy of the self-addressed, return overnight mailing label is attached as Exhibit 8. I explained in the letter that the self-addressed mailer was for Dr. Pandit's use in returning the completed assignment and declaration to me. In addition, I requested that the signed and dated assignment and declaration be returned to me at Morgan & Finnegan in five (5) business days after he had received it. On September 6, 2001, I used the overnight Federal Express tracking number to confirm that the assignment package had been delivered to Dr. Pandit's Gaithersburg, MD address. A copy of the Federal Express tracking information indicating that the overnight package had been delivered is attached as Exhibit 9.

11. In spite of several attempts to obtain the signed declaration and assignment documents from Dr. Pandit, he has not returned either an executed declaration or an executed assignment document as requested.

12. As set forth in ¶6 hereinabove, Dr. Pandit has also refused to sign the declaration and assignment documents for the related patent applications on which he is a named co-inventor and which were previously sent to him. The actions of Sunil Pandit, as recounted herein, evidence his unwillingness to cooperate in the filing of a complete patent application. In view of Dr. Pandit's continued refusal to execute and return the completed declaration and assignment papers sent to him within the requested time period and beyond, Sunil Pandit is and remains unresponsive and uncooperative. Accordingly, the above-identified patent application is made by the other

inventors on behalf of themselves and the nonsigning inventor, Sunil Pandit, in compliance with 37 C.F.R. §1.47(a).


STATEMENT OF CURRENT ADDRESS

13. Upon information and belief, Dr. Sunil Pandit's current residence address is 353 W Side Drive, Apt. 202, Gaithersburg, MD 20878-3028 USA.

14. Upon information and belief, Dr. Sunil Pandit's current telephone number is (301) 527-1324 for his residence address in Gaithersburg, MD.

15. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine, or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: November 26, 2001

By: 
Caryn DeHoratius
Reg. No. 45,881